

U.S Application No. 09/788,061, filed February 16, 2001
Attorney Docket No. 17463US02
Response dated September 22, 2008 to Provoke Advisory Action
In Response to Office Action Made Final mailed July 21, 2008

REMARKS

Claims 1-14 are pending. Claims 1-14 stand rejected.

Claim 8 stands rejected under 35 U.S.C. § 102 – an anticipation rejection.

In the Office Action made Final mailed July 21, 2008 (“Final Rejection”), the Examiner cites M.P.E.P. § 2144.04 relating to “making integral” to show that the claims are not necessarily patentable over the prior art due to the memory being or not being integrated to the processor.

It must be noted first that M.P.E.P. § 2144 is only applicable, if at all, to 35 U.S.C. § 103 and not 35 U.S.C. § 102. The Examiner is directed to look at the title of M.P.E.P. § 2144.

Thus, it is improper to cite M.P.E.P. § 2144 with respect to an anticipation rejection under 35 U.S.C. § 102 with respect to claim 8.

Thus, this is clearly U.S.P.T.O. error since the Examiner has no basis under 35 U.S.C. § 102 to maintain the anticipation rejection of claim 8.

Claim 8 should have been allowed over the prior art of record.

Also for consideration: if the Examiner had recognized his error in the previous Office Action (namely, that M.P.E.P. § 2144 does not support a rationale for an anticipation rejection under 35 U.S.C. § 102), then the Examiner would have corrected the error in a Non Final Office Action instead of mailing the Final Rejection.

If the Examiner decides to change the basis for the rejection under claim 8, which has not

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been amended, then the Examiner must do so under a Non Final Office Action since the change in the basis for the rejection for independent claim 8 is due to U.S.P.T.O. error. ***It is noted that no claims have been amended in the present application.***

In addition, the basis for M.P.E.P. § 2144.04, *In re Larson*, is not applicable here where the Examiner is attempting to re-interpret the named processor of Vanden Heuvel in a way that is different from the way the Vanden Heuvel interprets the processor, namely, processor 106.

Vanden Heuvel is the Examiner's only relied-upon evidence for what one of ordinary skill in the art would consider a processor. One of ordinary skill in the art would consider processor 106 as a processor. The evidence is Vanden Heuvel itself.

In view of the Examiner's own evidence, it appears that the Examiner is taking a view that is contrary from the teachings of Vanden Heuvel.

In view of the at least the above, the Examiner is requested to reconsider the Remarks of the Response filed April 1, 2008.

The Remarks from the Response filed April 1, 2008 are reproduced for reconsideration:

Independent claim 1 recites a processor "having" a memory.

Independent claim 8 recites a processor "comprising" a memory.

In the Response to Arguments section of the Office Action mailed November 1, 2007 ("Office Action"), the Examiner states the following:

Regarding the arguments pertaining to the memory, the claims do not state anything about the processor "containing" the memory. They only state the processor "having" a memory. Therefore, it does not matter

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whether or not the memory in the Vanden Heuvel reference is not inside the box. Both of the references show the memory connected and/or coupled to the processor. Therefore, both of the references used teaches the processor having a memory, and the examiner did not change his arguments with regards to claim 8 [and claim 1], the examiner only reopened prosecution because the examiner agreed that the Vanden Heuvel reference does not anticipate a wireless transceiver.

Office Action at pages 5 and 6.

Applicants respectfully request that the Examiner provide documentary evidence (e.g., case law) that supports the Examiner's interpretation of "comprising" and "having".

In other words, the Examiner is invited to provide case law in support of the proposition that B is not part of A in "A comprising B" or that B is not part of A in "A having B".

Applicants respectfully believe the Examiner's interpretation of "comprising" and "having" to be in error. Hypothetically, if a table has four legs, then the four legs are interpreted as being part of the table. This is the *plain meaning* of the phrase "has" or "having".

With respect to claim 1, a processor "having" a memory is interpreted as the memory as being part of the processor.

With respect to claim 8, a processor "comprising" a memory is interpreted as the memory as being part of the processor.

The Examiner admitted, in the Examiner's Response to Arguments section reproduced above, that "[b]oth of the references show the memory connected and/or coupled to the processor". Thus, as alleged, neither reference describes or teaches a memory as set forth in claims 1 and 8 that is part of a processor.

M.P.E.P. § 2111.03 states that "comprising" is synonymous with "including", "containing" or "characterized by" since it is inclusive or open-ended and does not exclude

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additional, unrecited elements or steps.

Therefore, since claim 8 recites a “processor comprising a memory”, the memory should be interpreted as being part of the processor and not merely connected and/or coupled to the processor as alleged by the Examiner.

M.P.E.P. § 2111.03 also states that “having” must be interpreted in light of the specification to determine whether open or closed claim language is intended. For the Examiner, the issue is not whether “having” is open ended or closed ended, but a more basic contemplation: whether “having” means “inclusion”.

M.P.E.P. § 2111.03 cites *Lampi Corp. v. American Power Prods. Inc.*, 228 F.3d 1365 (Fed. Cir. 2000) for the proposition that “the term ‘having’ was interpreted as open terminology, allowing the inclusion of other components in addition to those recited” (bold added).

In other words, a processor having a memory as set forth in claim 1 is interpreted as the memory being included as part of the processor.

Thus, the basis of the rejection of claims 1 and 8 as alleged by the Examiner in the Response to Arguments section of the Office Action is materially incorrect with respect to the Examiner’s interpretation of “comprising” and “having”.

Accordingly, the Examiner has not presented a *prima facie* rejection with respect to independent claims 1 and 8.

For at least the above reasons, the rejection of claims 1 and 8 cannot be maintained.

It is therefore respectfully requested that the rejection be withdrawn with respect to claims 1 and 8 and their respective rejected dependent claims (i.e., claims 2-7 and claims 9-14).

Conclusion

Applicants do not necessarily agree or disagree with the Examiner’s characterization of the documents made of record, either alone or in combination, or the Examiner’s characterization of recited claim elements. Furthermore, Applicants respectfully reserve the right to argue the

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characterization of the documents of record, either alone or in combination, to argue what is allegedly well known, allegedly obvious or allegedly disclosed, or the characterization of the recited claim elements should that need arise in the future.

With respect to the present application, Applicants hereby rescind any disclaimer of claim scope made in the parent application or any predecessor or related application. The Examiner is advised that any previous disclaimer of claim scope, if any, and the alleged prior art that it was made to allegedly avoid, may need to be revisited. Nor should a disclaimer of claim scope, if any, in the present application be read back into any predecessor or related application.

In view of at least the foregoing, it is respectfully submitted that the present application is in condition for allowance. Should anything remain in order to place the present application in condition for allowance, the Examiner is kindly invited to contact the undersigned at the below-listed telephone number.

The Commissioner is hereby authorized to charge any additional fees, to charge any fee deficiencies or to credit any overpayments to the deposit account of McAndrews, Held & Malloy, Account No. 13-0017.

Date: September 22, 2008

Respectfully submitted,

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